

REMARKS

The present Amendment is in response to the Office Action dated October 29, 2003 in reference to the above-identified application. The Examiner set a shortened statutory period for reply of three (3) months, making the present Amendment due by January 9, 2004. Filed concurrently herewith is a request for a three-month extension of time so that the present Amendment is due by April 9, 2004.

In the Office Action, claims 1-34 were pending. At the outset, Applicant notes with appreciation that the Examiner has indicated that claims 4, 8, 12, 13, 15, 21, 25, 30, 33, and 34 would be allowable if rewritten into independent form. The other pending claims, however, have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,156,186 to Mueller et al.

Before addressing the Office Action, Applicant notes with appreciation the telephone interview the Examiner courteously extended to Applicant's representative. During that telephone conversation, the relationship of the present patent application and that of Application Ser. No. 09/916,062 was discussed. As the Examiner may recall, both the present application and Application Ser. No. 09/916,062 claim the benefit of Application Ser. No. 09/322,745 filed May 28, 1999, which is now abandoned.

Application Ser. No. 09/916,062 has been allowed and the Issue Fee was timely paid on March 1, 2004. In view of the allowance of that case, Applicant has canceled several claims in the present application to leave pending those claims directed to different subject matter and/or having a different scope. Applicant notes for the Examiner's attention that it intends to proceed with the prosecution of this application on the basis of the subject matter of dependent claims 13-15, 20, 21, 25,

30 and 31. Accordingly, applicant canceled all the claims in the application and has rewritten each of the dependent claims 13-15, 20, 21, 25, 30 and 31 into independent form, which now respectively appear as new claims 35-42. Since the Examiner has indicated that original dependent claims 13, 15, 21, and 25 are allowable, then new claims 35, 37, 39, and 40 should now be in condition for allowance.

The remaining outstanding issues to be addressed in the office action, then, are the rejections of the following claims:

- original dependent claim 14, which depended from independent claim 1, now new claim 36,
- original dependent claim 20, which depended from independent claim 16, which is now new claim 38;
- original claim 30, which depended from independent claim 22, now new claim 41; and
- original claim 31, which depended from independent claim 22, now new claim 42.

Each of these claims has been rejected under 35 U.S.C. § 102(e) as being anticipated by Muller et al. Applicant has addressed these rejections with an appropriate declaration pursuant to 37 C.F.R. 1.131 to establish invention of the subject matter claimed, or falling within the claims, prior to the effective date of the Mueller et al. reference.

The Examiner will note that Mueller et al. has a filing date of October 30, 1998 and claims priority through eight (8) provisional applications as listed below:

1. App. No. 60/064,284 – filed October 30, 1997
2. App. No. 60/064,279 – filed October 30, 1997
3. App. No. 60/077,428 – filed March 9, 1998
4. App. No. 60/077,878 – filed March 13, 1998

5. App. No. 60/099,717 – filed September 10, 1998
6. App. No. 60/100,494 – filed September 16, 1998
7. App. No. 60/100,497 – filed September 16, 1998
8. App. No. 60/100,510 – filed September 16, 1998

A copy of most of the provisional applications has been provided herewith, however, Applicant's representative was unable to obtain a copy of App. No. 60/100,494 – filed September 16, 1998, which is the sixth application in the above list.

In an effort to assist the Examiner in his determination of Applicant's 1.131 Declaration, reference is made to certain page ranges in each of the seven provisional applications that have been enclosed herein. In so doing, Applicant does not intend to mislead the Examiner or in any way restrict the Examiner's review of the enclosed applications, but rather as a courtesy to the Examiner to better facilitate review of this Amendment.

The page ranges for each of the seven applications are as follows:

<i>Provisional Application</i>	<i>Page Range</i>
1. App. No. 60/064,284	pages: 8-11; 15-18; Fig. 1
2. App. No. 60/064,279	pages: 13-16; Fig. 1
3. App. No. 60/077,428	pages: 8-15; Fig. 1
4. App. No. 60/077,878	pages: 1-4; 8-12; Fig. 1
5. App. No. 60/099,717	Applicant was unable to obtain a copy of this application and thus has not read this application.
6. App. No. 60/100,494	pages: 5-11; Fig. 1
7. App. No. 60/100,497	pages: 8-11; Figs. 1 and 2
8. App. No. 60/100,510	pages: 5-12; Fig. 1

Applicant's 1.131 Declarations provides a showing of facts in the form of the declaration by the inventor, Juzer Jangbarwala, which is supported by two drawings dated February 22, 1998 and May 29, 1998 respectively, and the supporting declaration of Mr. Norman Volle, to prove invention of subject matter disclosed and claimed in the present patent application in the United States prior to the effective date of Mueller et al. with respect to at least that subject matter disclosed in the provisional applications identified as numbers 3 through 8, above.

More specifically, Mr. Jangbarwala declares that he conceived of using a nanofilter in order to improve the efficiency of a conventional electrowinning cell sometime in February 1998 and at least by February 22, 1998. This is evidenced by the diagram dated February 22, 1998, which is attached as Exhibit A to his declaration and discussed in paragraph 15 of his declaration and the supporting declaration of Mr. Volle. Clearly, the showing of facts establishes that Mr. Jangbarwala had more than a vague idea of how utilize an electrowinning cell in conjunction with a nanofilter with a goal toward making the electrowinning process more efficient.

After contemplating the use of a nanofilter in conjunction with an electrowinning unit, Mr. Jangbarwala diligently began to reduce his invention to practice between March and May of 1998. Particularly, as stated in his declaration, he engaged in extensive research of nanofiltration technology to satisfy himself that he could build a recycling unit that would meet the needs of Packard Hughes.

Ultimately, Mr. Jangbarwala arrived at the conclusion that utilizing a nanofilter in conjunction with an electrowinning cell would indeed increase the efficiency of the electrowinning cell and could be used as a component of the recycling system that would meet the needs of his customer, Packard Hughes. Accordingly, he designed a recycling system, and completed a CAD drawing of that system by May 29, 1998, which was later proposed to Packard Hughes. Clearly, then, Mr. Jangbarwala reduced to practice his invention sometime before May 29, 1998 because he was confident enough in his invention as to propose such an elaborate system to his customer.

The statements contained in the declarations of both Mr. Jangbarwala and Mr. Volle support a conception of various features of the invention disclosed and claimed in the present application sometime in February 1998. Furthermore, both declarations support a diligent reduction to practice of various features of the invention disclosed and claimed in the present application by May 29, 1998. Accordingly, at the very least, those features set forth in independent claims 1, 16, 22 and 32 have a date of invention prior to the effective date of Mueller et al. with respect to at least that subject matter disclosed in the provisional applications identified as numbers 3 through 8, above.

In light of these 37 C.F.R. § 1.131 declarations, Applicant believes that all claims of the present application, which were rejected over Mueller et al., taken either alone or in combination with other references, are allowable. Accordingly, of these claims, it is believed that new claims 36, 38, 41 and 42 are allowable over the Mueller et al. reference.

Due to this Amendment, a new filing fee calculation is provided, as follows:

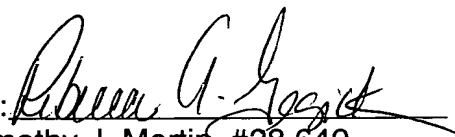
Maximum Total Claims This Amendment		Total Claims Previously Paid For	
8	-	34	= \$0.00
Total Independent Claims Per This Amendment		Maximum Independent Claims Previously Paid For	
8	-	4	= \$344.00
Additional Filing Fee Due			\$344.00

Accordingly, our check no. _____ in the amount of \$344.00 is enclosed. The Commissioner is hereby authorized to charge any deficiency in the payment of the required fee(s) or credit any overpayment to Deposit Account No. 13-1940.

Based on the foregoing, Applicant submits that the present application is in complete condition for allowance, and action to that end is courteously solicited. If any issues remain to be resolved prior to the granting of this application, the Examiner is requested to contact the undersigned attorney for the Applicant at the telephone number listed below.

Respectfully submitted,

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CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

I hereby certify that the foregoing **AMENDMENT (16 pages), including Declaration of Juzer Jangbarwala and attached Exhibits A-C, CHECK NO. 18274 IN THE AMOUNT OF 344.00 and Request for a 3-month Extension of Time (2 pages) and Check No. 18273 in the amount of \$950.00** is being deposited with the United States Postal Service as first-class mail in an envelope addressed to Mail Stop Fee Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 1st day of April, 2004.



Marcie F. King